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REMARKS

This is in response to the outstanding Office Action dated October 11, 2006.

Claims 1-16, 18-45, 49-51 and 59-61 have been previously canceled without prejudice or disclaimer. Claims 17, 46-48, 52-58, and 62-73 are pending. Claims 17, 55, and 67 have been amended. New claims 71-73 have been added.

In the outstanding Office Action, the amendment filed July 27, 2006 was objected to under 35 U.S.C. 132(a) as introducing new matter into the disclosure. Specifically, the Examiner asserts U.S. Application 09/292,488, now U.S. Patent 6,253,512, incorporated by reference does not disclose roof coverings having the predominant color blend in an amount that constitutes the specific percentages of 55%, 56% or 58% of all of the roof covering, respectively, or the range of over 50% of the roof covering. This objection is respectfully traversed.

U.S. Application 09/292,488, now U.S. Patent 6,253,512 issued to Thompson and incorporated by reference, discloses tabs having a predominant color blend in the specific percentages of 55%, 56% or 58%. As shown in Figure 1 of Thompson, the four rows 12, 14, 16 and 18 of tiles have an exposed portion 20 (Column 3, Lines 34-38). The exposed portions 20 are of four different colors, indicated at 22, 24, 26 and 28, respectively. Color 24 is aspen, a light gray color. (Column 3, Lines 40-45). As shown in Figure 1, there are a quantity of 36 total tiles and a quantity of 20 tiles having the aspen 24 light gray color. Consequently, the percentage of predominant color blend, aspen 24, is calculated as 20/36 or 55.6%. Similarly, the percentage of predominant color blend, aspen 24, is calculated as 20/36 or 55.6% in alternate embodiments as shown in Figures 2 and 4.

Similarly, as shown in Figure 6 of Thompson, a roof is covered by the pattern units according to the pattern units of Figures 1-4. As shown in Figure 6, there are a quantity of 580 total tiles and a quantity of 327 tiles having the predominant color blend, aspen 24, light gray color. The resulting percentage of predominant color blend aspen 24 is calculated as 327/580 or 56.4%.

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Finally as shown in Figure 3 of Thompson, there are a quantity of 36 total tiles and a quantity of 21 tiles having the predominant color blend, aspen 24, light gray color. The resulting percentage of predominant color blend, aspen 24, is calculated as 21/36 or 58.3%. Therefore, since the Thompson reference was incorporated by reference into the present application and since the Thompson reference disclosed a predominant color blend in the specific percents of 55%, 56% or 58%, then the introduction of the specific and predominant color blends of 55%, 56% or 58% in the present application does not introduce new matter into the disclosure of the invention. Further, since there is a direct disclosure of roof covering where the predominant color occurs 60 % of the time, there is an overall disclosure of 55%, 56%, 58%, and 60%. Given the totality of these disclosures, there is support for the addition to the specification of the roof covering where the predominant color occurs in over 50% of the roof covering. Accordingly, Applicant requests withdrawal of the objection under 35 U.S.C. §132(a).

In the outstanding office action, dependent claims 52-54, 62-64 and 69 were rejected under 35 U.S.C. §112, first paragraph, for failure to provide an adequate written description. Specifically, the Examiner asserts the specification fails to describe or discuss the specific percentages now claimed. The rejections are respectfully traversed for the reasons outlined above. Applicant has shown that the introduction of the disputed language is proper and is fully supported by the Thompson patent. Accordingly, Applicant requests withdrawal of the rejection under 35 U.S.C. §112, first paragraph.

In the outstanding Office Action, independent claim 67 was rejected under U.S.C. 103(a) as being unpatentable over Phillips in view of Overbury.

Independent claim 67 has been amended to specify that the roof covering has a frequency of tabs of the predominant color blend that is sufficiently prevalent to provide the roof covering with an appearance that simulates a natural slate roof. The roof covering having this structure is an extremely valuable design, having propelled

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the Owens Corning Berkshire® shingle to a surprising level of sales for a new product, and having spurred on imitative shingle products by at least one competitor.

Phillips discloses a roof covering having a wood shake appearance, and therefore lacks any suggestion for a roof covering providing the appearance of a natural slate roof. See, for example, the roof covering shown in Fig. 5, which gives the appearance of a wood shake roof. Also, Phillips discloses nothing about tab coloring or a predominant color configuration, other than the disclosure of shadow areas.

The Overbury reference relates to a method of reclaiming factory seconds, or single-layer tabbed shingles with imperfections. The butt edges of the reclaimed shingles are cut by hand to remove the imperfect parts and define an irregularly shaped tab. Additional asphalt and granular material may then be added by hand to the reclaimed and cut shingles to cover and seal the newly cut edges. The additional granular material covers surface imperfections. Overbury specifically discloses that the additional granules may be configured so that the tabs of a shingle may be of different colors, with each tab having what could be described as a single color blend. In Overbury's primary embodiment, each shingle has three tabs, with each of the tabs having a single color blend, with no two tabs of the same color blend, and with each shingle being identical to all the other shingles. Overbury further states that there can be occasional deviations from the primary embodiment. This deviation is explained in the specification at page 2, lines 93-96, where Overbury states that

...each tab will have a solid color different from other tabs in the strip, although if desired two or more adjacent tabs may now and then be given the same color.

Applicant notes that the statement includes the language "now and then", which is an indication as to the frequency of the condition wherein the two adjacent tabs have the same color. Applicant contends that this language would be interpreted by a

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person skilled in the art as significantly limiting or restricting the occurrence of multiple tabs of the same color in the same shingle. The Merriam-Webster Online Dictionary defines "now and then" as meaning "occasionally" or "from time to time". One skilled in the art would expect shingles having multiple tabs of the same color blend in a single shingle to occur only occasionally, and would not expect them to occur with such a frequency as would result in a roof covering having a predominance of one color. The phrase "now and then" would connote only infrequent deviations from the norm. In Overbury, the norm would be all tabs of each shingle being of a distinct color, and no two tabs being alike. Therefore, adding Overbury to Phillips would result in a combination where, although the tabs of each shingle might be of different colors as taught by Overbury, and some of the shingles might occasionally have more than one tab of the same color as taught by Overbury, the overall effect would not be a roof covering that has the appearance of a natural slate roof. The roof covering resulting from the combination of Phillips and Overbury would not have enough of any one color to look like a natural slate roof. In this respect the combination of Overbury with Phillips fails to make out a *prima facie* case of obviousness, since the combination fails to meet all the limitations of the claim.

The Examiner maintains in Paragraph 9 of the Office Action that Overbury's "now and then" statement is merely an expression of a lesser preferred embodiment. Applicant agrees with the Examiner that Overbury teaches an alternate embodiment here – an embodiment where there are more tabs of one color than of the other colors. However, Applicant contends that the substance or content of this alternate embodiment does not result in a roof covering having the appearance of a natural slate roof. The leap required to reach an appearance of a natural slate roof from Overbury's teaching of an extra tab "now and then", or of Overbury's Fig. 6 showing one tab wider than the others, is simply too great for the rejection to meet the requirements of a *prima facie* case of obviousness. Neither "now and then", or a shingle having one tab wider than the others is sufficient to alert one skilled in the art that a natural slate

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appearance could be made from these two references. The combination of Overbury and Phillips would not result in a roof covering wherein one of the color blends of the tabs occurs more frequently than any of the other color blends to the extent that the appearance of the roof covering simulates a natural slate roof. Therefore, at least for this reason the combination of Phillips and Overbury fails to teach or suggest the invention defined in claim 67. Accordingly, Applicant requests withdrawal of the rejection under 35 U.S.C. §103.

Dependent claims 68-70 and 73 depend from independent claim 67, and for at least this reason, are also patentable. With respect to claim 73, even though Overbury shows in Fig. 6 that one of tabs is larger than the others, this is still not a teaching that the overall effect of the roof covering of such shingles would be to afford the roof covering an appearance of a natural slate roof.

In the outstanding Office Action, independent claims 17 and 55 were rejected under U.S.C. 103(a) as being unpatentable over Hulett in view of Overbury. The Examiner asserts that Hulett provides laminated shingles having overlay members provided with a plurality of generally rectangular tabs (Figures 5,6 and 8) separated by cutouts and underlay members provided with darker granules for a more pleasing appearance. The cutouts are shown narrow when compared to the tabs. However, as noted by the Examiner, Hulett fails to teach that the color blends of the tabs of the overlay members are different from another with one of the color blends occurring more frequently than any of the other color blends. The Examiner also notes that Hulett fails to specify gray as the predominant color blend.

To overcome the deficiencies in Hulett, the Examiner relies on Overbury. The Examiner asserts that Overbury teaches tabs of different colors and to confine each color to the portion of the shingle which corresponds to one tab for aesthetic purposes. The Examiner further asserts that Overbury provides that if desired two or more tabs may be given the same color and multiple tabs of different colors, with one of the tabs (left most) being predominant.

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Even if the most pertinent portions of Overbury are added to the disclosure of Hulett, as suggested by the Examiner, the overall effect would not be a roof covering that has the appearance of a natural slate roof. The roof covering resulting from the combination of Hulett and Overbury would not have enough of any one color to look like a natural slate roof. In this respect the combination of Overbury with Hulett fails to make out a *prima facie* case of obviousness, since the combination fails to meet all the limitations of the claim. The combination does not include a roof covering wherein one of the color blends of the tabs occurs more frequently than any of the other color blends to the extent that the appearance of the roof covering simulates a natural slate roof, as provided in claim 17. Further, the combination does not include a roof covering wherein tabs having a grey color blend occur more frequently than any of the other color blends to the extent that the appearance of the roof covering simulates a natural slate roof, with gray as the predominant color, as defined in claim 55. Therefore, at least for this reason the combination of Hulett and Overbury fails to teach or suggest the invention defined in claims 17 and 55. Accordingly, Applicant requests withdrawal of the rejection under 35 U.S.C. §103.

Dependent claims 46-48, 52-54, 65 and 71 depend on amended independent claim 17 and for at least this reason, are also patentable.

Dependent claims 56-58, 62-64, 66 and 72 depend on amended independent claim 55 and for at least this reason, are also patentable.

In the outstanding Office Action, independent claims 17, 55 and 67 were rejected under U.S.C. 103(a) as being unpatentable over Bondoc in view of Overbury. Bondoc discloses

The Examiner asserts that Bondoc provides laminated shingles having overlay members provided with a plurality of generally rectangular tabs 16 and separated by narrow cutouts, which have beveled edges in the embodiment of Figures 4A-4C, and underlay members 11, 15 provided with darker granules. The cutouts are shown narrow when compared to the tabs. However, as noted by the Examiner, Bondoc fails

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to teach that the color blends of the tabs of the overlay members are different from another, with one of the color blends occurring more frequently than any of the other color blends. The Examiner also notes that Bondoc fails to specify gray as the predominant color blend.

To overcome the deficiencies in Bondoc, the Examiner relies on Overbury. The Examiner asserts that Overbury teaches tabs of different colors and to confine each color to the portion of the shingle which corresponds to one tab for aesthetic purposes. The Examiner further asserts that Overbury provides that if desired two or more tabs may be given the same color and multiple tabs of different colors, with one of the tabs (left most) being predominant.

For the same reasons disclosed above with respect to the Phillips and Hulett references, the combination of Bondoc and Overbury does not teach a roof covering as claimed in Applicant's independent claims 17, 55 and 67. The roof covering resulting from the combination of Bondoc and Overbury would not have enough of any one color to look like a natural slate roof. In this respect the combination of Overbury with Bondoc fails to make out a *prima facie* case of obviousness, since the combination fails to meet all the limitations of the claim. The combination does not include a roof covering wherein one of the color blends of the tabs occurs more frequently than any of the other color blends to the extent that the appearance of the roof covering simulates a natural slate roof, as provided in claims 17 and 67. Further, the combination does not include a roof covering wherein tabs having a grey color blend occur more frequently than any of the other color blends to the extent that the appearance of the roof covering simulates a natural slate roof, with gray as the predominant color, as defined in claim 55. Therefore, at least for this reason the combination of Bondoc and Overbury fails to teach or suggest the invention defined in claims 17, 55 and 67. Accordingly, Applicant requests withdrawal of the rejection under 35 U.S.C. §103.

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In Paragraph 9 of the Office Action the Examiner discounts Applicant's declaration under 35 CFR §1.132 pertaining to commercial success. The Examiner cites *Cable Electric Products, Inc. v. Genmark, Inc.*, 226 USPQ 881 (CAFC 1985), stating that Applicant's declaration lacks requisite proof of nexus between the commercial success and the claimed invention. In a more recent case, *Demaco Corp. v. F. Won Langsdorff Licensing Ltd.*, 7 USPQ 2d 1222 (CAFC 1988) the CAFC more comprehensively set out the requirements of commercial success. The Court stated at page 1226 that:

When a patentee asserts that commercial success supports its contention of nonobviousness, there must of course be a sufficient relationship between the commercial success and the patented invention. The term "nexus" is often used, in this context, to designate a legally and factually sufficient connection between the proven success and the patented invention, such that the objective evidence should be considered in the determination of nonobviousness. The burden of proof as to this connection or nexus resides with the patentee. See, e.g., *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1027, 226 USPQ 881, 888 (Fed.Cir. 1985). In meeting its burden of proof, the patentee in the first instance bears the burden of coming forward with evidence sufficient to constitute a *prima facie* case of the requisite nexus. See *Texas Dept. of Community Affairs v. Burdine*, 450 U.S. 248, 254 n.7 (1981):

The phrase "prima facie case" . . . may be used by courts to describe the plaintiff's burden of producing enough evidence to permit the trier of fact to infer the fact at issue.

(citing 9 J. Wigmore, Evidence §2494 (3d ed. 1940) (hereinafter Wigmore)); E.W. Cleary, McCormick on Evidence §342 (3rd ed. 1984) (hereinafter McCormick): The judge, using ordinary reasoning, may determine that fact A might reasonably be inferred from fact B, and therefore that the party has satisfied his burden [of producing evidence], or as sometimes put by the courts, has made out a "prima facie" case. [footnotes omitted]

A *prima facie* case of nexus is generally made out when the patentee shows both that there is commercial success, and that the thing (product or method) that is commercially successful is the invention disclosed and claimed in the patent.

In view of the CAFC opinion in the *Demaco* case above, Applicant contends that in the present application, a *prima facie* case of nexus has been made out by the facts set out in the Elliott declaration. Before Owens Corning introduced the Berkshire® shingle in early 2003, there was nothing in the residential shingle market

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giving customers a roof covering having the appearance of a natural slate roof. Once this brand new product was introduced, it immediately produced significant sales, and the product is a commercial success. Further, the shingles are covered by the patent claims of the present application. Until Owens Corning's competitor CertainTeed copied the Owens Corning Berkshire® shingle in mid-2004, Owens Corning had 100 percent of the market share of the slate-looking shingle product market. Now, with a competitive me-too product having been introduced, Owens Corning's market share has gone down to a level well below 100 percent. The Elliott declaration states in Paragraph 13 that the product has been enthusiastically received. As stated in Paragraph 15, there have been no extraordinary advertising efforts. The picture painted by the declaration makes it clear that the commercial success is directly the result of the appearance of the roof covering achieved by the claimed invention. Applicant respectfully requests that the Examiner reconsider this issue in view of the facts set out in the Elliott declaration.

In view of the above amendment and remarks, the Applicant has shown that the claims are in proper form for allowance, and the invention, as defined in the claims, is not taught or suggested by the applied references. Accordingly, the Applicant respectfully requests reconsideration and withdrawal of the objections and rejections of record, and allowance of all claims.